CLERK'S COPY.

TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, ~~1929~~

No. ~~650~~

LOUIS H. ENSTEN AND LION KNITTING MILLS COMPANY, PETITIONERS,

vs.

SIMON ASCHER & COMPANY, INCORPORATED

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR CERTIORARI FILED FEBRUARY 10, 1930

CERTIORARI GRANTED MARCH 12, 1930

(34,781)

(34,781)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1929

No. 650

LOUIS H. ENSTEN AND LION KNITTING MILLS COMPANY, PETITIONERS,

vs.

SIMON ASCHER & COMPANY, INCORPORATED

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

INDEX.

	Original	Print
Record from the district court of the United States, Southern New York	1	1
Bill of complaint	1	1
Order to show cause	8	5
Affidavit of L. H. Ensten	10	7
Exhibit 1—Final decree, district court of the United States, Northern Ohio, Ensten vs. Rich-Sampliner Co.	13	9
Exhibit 2—Letters patent No. 1,313,080	18	11
Exhibit 6—Advertisement inserted in Earnshaw publication	22	16
Affidavit of Edwin A. Harris	23	16
Exhibit 1—Notice of infringement	27	19
Affidavit of Abraham Nitzberg	28	19
Exhibit 3—Illustration from "Sweater News"	33	22
Affidavit of L. H. Ensten	34	22

JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., MARCH 22, 1930

	Original	Print
Opinion, Coffey, J.	40	26
Final decree	43	28
Petition for appeal and assignments of error	44	28
Order allowing appeal	45	29
Citation and service (omitted in printing)	45	
Stipulations re transcript of record	46	29
Clerk's certificate (omitted in printing)	50	
Proceedings in the United States circuit court of appeals, second circuit	51	31
Opinion per curiam	51	31
Decree	56	33
Clerk's certificate (omitted in printing)	57	
Order allowing certiorari	58	34

[fols. a-1]

IN UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

In Equity. No. —

Louis H. Ensten and Lion Knitting Mills Company, Exclusive Licensee, Plaintiffs,

against

Simon Ascher & Co., Inc., Defendant

On Patent No. 1,313,080

Bill of Complaint—Filed November 9, 1929

To the Honorable Judges of the District Court of the United States in and for the Southern District of New York, sitting in equity:

Plaintiffs bring this its bill in equity against the defendant herein named, and complains and says:

I

Parties

1. Plaintiff, Louis H. Ensten, is a citizen of the State of Ohio, and a resident of the City of Cleveland, in the State of Ohio.

[fol. 2] 2. Plaintiff, Lion Knitting Mills Company, is a corporation duly organized and existing pursuant to the laws of Ohio, a licensee under the patent in suit hereinafter mentioned.

3. Defendant, Simon Ascher & Co., Inc., is a corporation duly organized and existing under and by virtue of the laws of the State of New York, and a citizen and inhabitant of said State, with a regular and established place of business at 1 East 35th Street, in the Borough of Manhattan, City of New York and County of New York, in said state.

II

Jurisdiction

4. This is a suit in equity arising under the patent laws of the United States for infringement of the United States Letters Patent below described.

And for their cause of action, plaintiffs allege:

III

Cause of Action

5. Prior to the 30th day of April, 1919, Louis H. Ensten was the first, original and sole inventor of the improvements and inventions described and claimed in United States Letters Patent numbered 1,313,080, which improvements and inventions were not known or used by others in [fol. 3] this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to the date upon which he made application for Letters Patent therefor as hereinafter set forth, and not in public use or on sale in this country for more than two years prior to the date of his said application, and not abandoned, and not patented or caused to be patented by himself or his legal representatives or assigns in any country foreign to the United States upon an application filed more than twelve months prior to the filing of his said application in this country. Being entitled to a patent for the said improvements and inventions under the provisions of the statutes of the United States then in force, the said Louis H. Ensten did, on the 30th day of April, 1919, duly file in the United States Patent Office an application for Letters Patent therefor.

6. Thereafter, and on the 12th day of August, 1919, all requirements of the statutes of the United States then in force having been duly complied with, Letters Patent of the United States for said inventions and improvements, signed, sealed and executed in due form of law, were duly issued to the said Louis H. Ensten, and the Letters Patent so issued was numbered 1,313,080.

7. Plaintiff, Lion Knitting Mills Company of Cleveland, Ohio, is engaged in the business of manufacturing and sell- [fol. 4] ing knitted goods, and particularly knitted caps using the invention of the Ensten patent herein in suit, numbered 1,313,080, and that it is and has been for many years last past an exclusive licensee under said patent, this license being an oral license, and it has been ever since the date of the issuance of Letters Patent on Aug. 12th, 1919.

8. The said inventions and improvements patented aforesaid in Letters Patent No. 1,313,080 are of great value and utility to the plaintiffs and to the public generally; and the plaintiffs, since the date of invention thereof, have caused to be manufactured a very large number of knitted caps embodying the said invention and improvements. The plaintiffs have expended large sums of money in causing the said invention and improvements to be developed and have built up a large and profitable business for the exploitation and sale of knitted caps manufactured and produced by said plaintiff corporation, so that the said invention and improvements, and the patent rights relating to the same, have been and are of great utility and value to the plaintiffs, and but for the unlawful acts of the defendant herein complained of, would have been of greater benefit and value to them.

9. Defendant, well knowing the premises and with intent to injure and defraud the plaintiffs has, since the grant of said Letters Patent and within six years prior to the filing of this Bill of Complaint, and within the Southern District of New York, and elsewhere, infringed upon said Letters Patent, by making and using and selling knitted caps [fol. 5] embodying the improvements, and invention thereof, and threatens to continue so to infringe, all to the great and irreparable damage of the plaintiffs and to the unlawful gain and profit of the defendant.

10. Defendant, as plaintiffs are informed and believe and therefore aver, has derived and received, and will derive and receive from the infringement complained of, large gains, profits and advantages but to what amount the plaintiffs are not informed and cannot set forth. By reason of the said infringement the plaintiffs have been and, unless such infringement be forthwith restrained by this court,

will be deprived of and prevented from, receiving the gains, profits, and advantages to which they are lawfully entitled and which they would have derived and received, and would now be deriving and receiving but for the said infringement. By reason of the said infringement, the plaintiffs have been irreparably injured, and have sustained losses and damages therefrom, and unless the infringement complained of be immediately restrained, further irreparable injury and loss and damage will be caused to the rights of the plaintiffs under said Letters Patent.

11. Plaintiffs have manufactured and used, since the date of said invention, a substantial number of knitted caps embodying the improvements and invention of said patent, and has affixed thereto the word "patented" together with the date of the patent aforesaid as provided by Section 4900 [fol. 6] of the Revised Statutes of the United States. Plaintiffs have, prior to the date of the filing of this suit, duly notified the defendant of their rights in the premises, and of the fact that the defendant was infringing thereupon, but the defendant has continued, after such notice, to make, use and sell the knitted caps embodying the improvements and invention of said patent.

12. The plaintiffs have no plain, adequate and complete remedy at law.

IV

Prayer for Relief

Wherefore plaintiffs pray:

1. For a decree adjudging and declaring that the said Letters Patent No. 1,313,080 are good and valid and owned by the said Louis H. Ensten, and have been infringed by the defendant.

2. That a preliminary injunction may be issued enjoining and restraining said defendant and its officers, agents, servants, and employees, and each and all of them, as well as any and all persons acting or claiming to act on behalf of them or any of them, from directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold articles embodying the inventions of said

Letters Patent No. 1,313,080; and from infringing upon and/or violating the rights of the plaintiffs in said Letters [fol. 7] Patent in any way whatsoever, pending the determination of this suit and until further order of this court.

3. That a perpetual injunction may be issued of the same tenor and effect as the preliminary injunction hereinabove prayed for.

4. That defendant be ordered and decreed to deliver up to the plaintiffs each and all of the said infringing articles which it has in its possession or under its control, or that the same may be destroyed, or delivered into the court or impounded by the court for such final disposition as to it may seem just and proper.

5. That defendant be required to account for and pay over to the plaintiffs such gains and profits as have accrued or arisen or been earned or received by them, or any of them, from the unlawful manufacture, use or sale of the invention patented in and by the Letters Patent aforesaid, and in addition thereto, the damages plaintiff have sustained thereby; and that the amount of the damages for said infringement may, in view of the wanton character of the infringement, be increased to a sum not exceeding three times the amount thereof.

6. That defendant be decreed to pay the cost of this suit.

[fol. 8] 7. That plaintiffs may have such other, further and different relief as the circumstances and the equity of the case may require.

Lion Knitting Mills Company, by L. H. Ensten, Secretary. L. H. Esten, Plaintiff. O. Ellery Edwards, Solicitor for Plaintiffs.

IN UNITED STATES DISTRICT COURT

ORDER TO SHOW CAUSE

Upon the verified bill of complaint herein and the supporting affidavit of Louis H. Ensten, and the exhibits referred to therein, and on motion of the plaintiffs,

Let the defendant, Simon Ascher & Co., Inc., show cause before this Court at Room 235 in the United States Court House and Post Office Building, Broadway and Park Row, in the Borough of Manhattan, City, County and State of New York, on the 22nd day of November, 1929, at 10:30 A. M., or as soon thereafter as counsel can be heard, Why a preliminary injunction should not issue herein restraining and enjoining the defendant, Simon Ascher & Co., Inc., its officers, agents, partners, servants, and employees, and each and all of them, as well as any and all persons acting or claiming to act on behalf of them or any of them, from [fol. 9] directly or indirectly making or causing to be made, using or causing to be used, selling or causing to be sold, machines or devices embodying the inventions of Letters Patent of the United States No. 1,313,080, and from infringing upon or violating the rights of plaintiffs in said Letters Patent in any way whatsoever, pending the determination of this suit and until further order of this Court; and it is further.

Ordered—

1. That copies of the bill of complaint herein, the supporting affidavit together with its exhibits, and this order be served on the defendant by the Marshal on or before 6 o'clock on Tuesday, November 14, 1929;

2. That answering affidavits, if any, be served on plaintiffs' solicitor, O. Ellery Edwards, at his office in Room 1677, #233 Broadway, New York City, at or before 12 o'clock noon on Tuesday, November 19, 1929;

3. That rebuttal affidavits, if any, may be served upon the defendant or any counsel who may appear to represent it at the time and place above named for the hearing of this order to show cause.

Dated New York, N. Y., November 9, 1929.

Bondy, United States District Judge.

[fol. 10] IN UNITED STATES DISTRICT COURT

AFFIDAVIT OF L. H. ENSTEN—Verified November 8, 1929

Louis H. Ensten, being duly sworn, deposes and says:

I am one of the plaintiffs in the above entitled case and am familiar with facts and circumstances connected therewith.

I further depose and say that the patent in suit, No. 1,313,080, was taken out by me under date of August 12, 1919, and thereafter became involved in a suit against the Rich-Sampliner Company in the United States District Court of Cleveland, Ohio, under date of August 20th, 1920, and on May 24th, 1922, that court entered an interlocutory decree holding Claims 1, 3, 4 and 5 valid and infringed, and claim 2 invalid.

On June 10, 1922, an appeal was taken by the defendants to the Circuit Court of Appeals, Sixth Circuit, known as appeal #3776. In due season this Circuit Court of Appeals rendered an opinion under date of June 30th, 1923, and a mandate was filed October 18th, 1923. The upper court affirmed the lower as to validity and infringement of Claims 1, 3, 4 and 5 of said Letters Patent, but did not pass on the validity of Claim 2. The opinion of this Court will be found reported in 291 Fed. 1003.

Thereafter the case went to an accounting and there was a consolidation, one party plaintiff being added and additional defendants being added, by way of supplemental bill, and thereafter, upon motion and hearing, the District Court dismissed the bill of complaint, because a disclaimer to [fol. 11] Claim 2 had not been promptly filed. This opinion was rendered by Judge Westenhaver and will be found at 13 Fed. 2nd 132. From this decision of Judge Westenhaver, the plaintiffs appealed and Judge Westenhaver was reversed and the opinion of reversal is found in 19 Fed. 2nd 66. Thereafter, by consent, an order was entered in behalf of the plaintiffs finally determining the case, the defendants settling in the liquid sum of over $23,000.00, as appears by this final decree. A copy of this final decree is annexed hereto and made a part hereof, as Exhibit 1, and I make a copy of the patent in suit Exhibit 2.

The final decision of the Court of Appeals for the Sixth Circuit was rendered May 9th, 1927, and the final decree was entered November 1st, 1928.

I farther depose and say that since the plaintiffs have been in business, they have commercially exploited the invention of the patent in suit by making caps of the form and kind shown in said Letters Patent, Exhibit 2, and which cap is carrying a tag bearing the legend "Patented August 12, 1919," and also the trade mark "Ace" under which the cap is sold, and the plaintiffs have built up an extensive business, manufacturing and selling being done by the Lion Knitting Mills Company, a corporation owned and controlled by me for the purpose of exploiting my inventions of various kinds including the invention of the patent in suit. A sample cap and label of plaintiffs' manufacture I identify as Exhibit 3. This cap is made by making a swatch of the [fol. 12] type and character shown in Exhibit 4. From this swatch the cap is made as directed in the patent in suit.

I further depose and say that the plaintiffs have built up a substantial business based on the invention of this patent, have advertised extensively, and that the article has met with great success and is very popular with the trade.

I further depose and say that certain infringements have arisen and one of these is by the defendant hereto, who has made and sold caps of the exact type and character shown and described in the Letters Patent in suit and exemplified in Exhibit 3.

This manufacturing and these sales were made before and subsequent to April of this year. I identify one cap so made and sold as Exhibit 5. I also identify an advertisement of the defendant as Exhibit 6, which is an advertisement inserted by the defendant in a publication known as Earnshaw, and which was inserted during the current year. Exhibit 6 is a photostat of the original advertisement.

I further depose and say that now that this patent has been sustained by the highest court of the Sixth Circuit, after protracted litigation, and substantial recovery of over $23,000.00 has been had, I am proceeding to bring suit against all infringers based on this patent and on this suit and recovery, and I ask that I be given a temporary injunction forthwith, so that my rights may be amply protected in

the premises, and these infringements cease forthwith, and if this be not done, I will suffer irreparable damage from these infringements.

[fol. 13] I further depose and say that my Company, The Lion Knitting Mills Company, my co-plaintiff in this action, will also suffer irreparably if this injunction be not granted.

PLAINTIFFS' EXHIBIT 1 TO AFFIDAVIT OF L. H. ENSTEN

Filed Nov. 1, 1928. B. C. Miller, Clerk U. S. District Court, N. D. O.

UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

Equity. No. 573

LOUIS H. ENSTEN and THE LION KNITTING MILLS COMPANY, a Corporation, Plaintiffs,

vs.

THE RICH-SAMPLINER COMPANY, a Corporation; THE RICH-Sampliner Knitting Mills Company, a Corporation, and The Rose Knit Goods Company, a Corporation, Defendants

Final Decree

This cause came on to be heard at the October Term of this Court upon the amended Bill of Complaint filed in this [fol. 14] Court on January 11, 1926, and accepted as such amended Bill by Order filed July —, 1927, and upon a motion of Harold Elno Smith, Esq., plaintiffs' solicitor, and upon reading the annexed Consent of the defendants, it is, pursuant to such consent, ordered, adjudged and decreed:

1. That the Lion Knitting Mills Company, Plaintiff, is exclusive licensee of Louis H. Ensten under United States Letters Patent No. 1,313,080 and that the Defendants, by infringing upon said Letters Patent, have infringed upon the exclusive rights of said The Lion Knitting Mills Company thereunder.

2. That the Lion Knitting Mills Company, Plaintiff, is entitled to have and is hereby awarded all the rights and privileges of a party plaintiff in, to, and under the interlocutory decree filed herein on May 24, 1922, the same as though it had been named therein as a party plaintiff, and said interlocutory decree is hereby made final in behalf of the plaintiff The Lion Knitting Mills Company as well as of the plaintiff Louis H. Ensten.

3. That the plaintiffs do recover of the defendants, all the profits, gains, and benefits which the defendants have derived, received, or made since the 12th day of August, 1919, by reason of their infringement of such first, third, fourth and fifth claims of said Letters Patent, and that the plaintiffs do recover of the said defendants all damages which they have suffered and sustained since that date, as [fol. 15] well as the damages of The Lion Knitting Mills Company, plaintiff, as also the damages of Louis H. Ensten, plaintiff.

4. And whereas the parties hereto have agreed that the profits and damages occasioned by the joint and several acts of these defendants, both as against Louis H. Ensten, plaintiff and against The Lion Knitting Mills Company, plaintiff, shall be esteemed equivalent to the sum of Twenty-three Thousand Dollars ($23,000.00), and that upon such payment, and a notation thereof on the records of this Court, all claims against the said defendants both jointly and severally, by reason of any and all infringements by them or either of them of the said Letters Patent No. 1,313,080 prior to the date hereof, shall be satisfied and discharged.

5. It is further ordered, and decreed that in view of the agreement of the parties on the sum to cover damages and profits, the reference to Hon. C. D. Friebolin as Master, is hereby vacated, and said Master is hereby discharged and relieved of any further consideration of this case.

6. It is further ordered, adjusted and decreed that whereas the value of the damages and profits hereinbefore stated is based upon the agreement that each party shall pay its own costs, no costs shall be taxed.

7. It having heretofore been noted upon the records of this Court that the said damages and profits have actually

PLAINTIFF'S EXHIBIT NO. 18 TO AFFIDAVIT OF L.H.ENSTEN

L. H. ENSTEN.

KNITTED CAP.

APPLICATION FILED APR. 30, 1919.

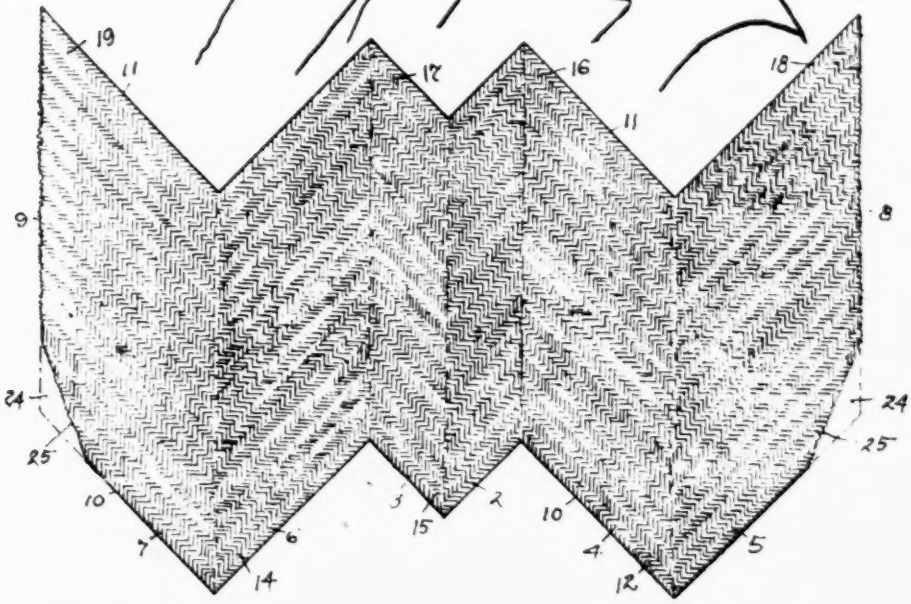
1,313,080.

Patented Aug. 12, 1919.

2 SHEETS- SHEET 1

FIG. 1

FIG. 2



Inventor
Louis H. Ensten

Witness
Geo B. Kueser.

By Fraser & Kueser

Attorney

19

L. H. ENSTEN.

KNITTED CAP.

APPLICATION FILED APR. 30, 1919.

1,313,080.

Patented Aug. 12, 1919.

2 SHEETS—SHEET 2.

FIG. 3

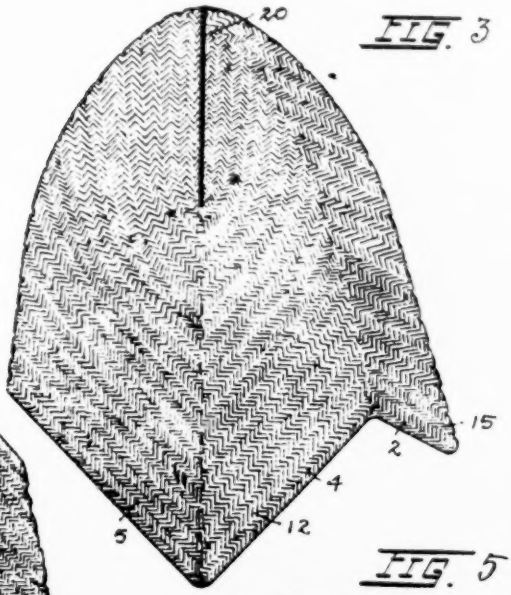


FIG. 4

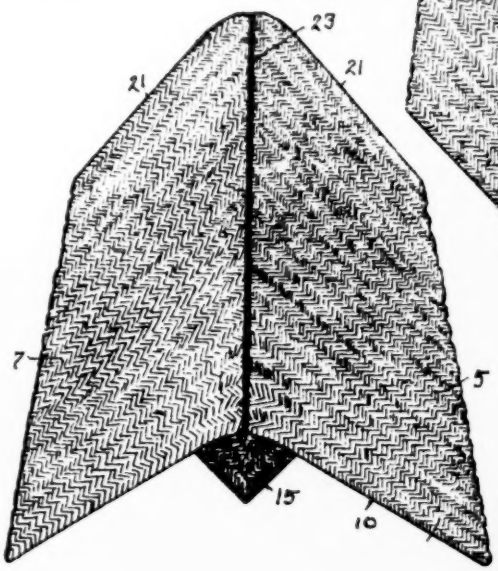
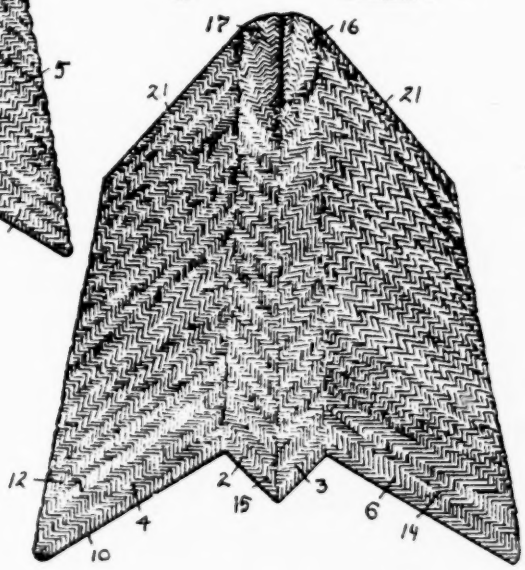


FIG. 5



Inventor

Louis H Ensten

Witness

Geo. E. Kricker.

By Fuller & Hubbard

Attorneys

[fol. 16] been paid by the defendants to the plaintiffs, and payment of the costs effected by the respective parties, this decree is made final.

The parties hereto by their solicitors, consent, stipulate and agree to the foregoing decree and all the parts and provisions thereof.

Harold Elno Smith, Solicitor for Plaintiffs.

Cleveland, Ohio, October 31, 1928.

Albert Lynn Lawrence, Solicitor for Defendants.

Cleveland, Ohio, October 31, 1928.

Plaintiffs hereby confess and acknowledge the receipt of the sum of Twenty-three Thousand Dollars ($23,000.00) from the defendants in full compliance with and satisfaction of the above decree.

L. H. Ensten, The Lion Knitting Mills Company, by L. H. Ensten, Secretary.

Cleveland, Ohio, October —, 1928.

[fol. 17] I, C. D. Friebolin, hereby acknowledge the receipt from the plaintiffs of all my fees and charges and expenses as such Special Master heretofore incurred in connnection with the above litigation.

C. D. Friebolin.

Cleveland, Ohio, October —, 1928.

I, B. C. Miller, Clerk, hereby certify that I have on hand sufficient money on deposit in behalf of the plaintiffs and on behalf of the defendants to satisfy all costs of the respective parties.

B. C. Miller, Clerk. Leonard C. Meon, Deputy Clerk.

Cleveland, Ohio, October —, 1928.

This decree signed and filed at Cleveland, Ohio, at a stated term of the above Court this 1st day of November, 1928.

Paul Jones, U. S. District Judge.

(Here follow drawings, side folios 18 and 19)

PLAINTIFF'S EXHIBIT NO. 2 TO AFFIDAVIT OF L. H. ENSTEN

[fol. 20] United States Patent Office

Louis H. Ensten, of Cleveland, Ohio

Knitted Cap

Specification of Letters Patent

1,313,080. Patented Aug. 12, 1919

Application filed April 30, 1919. Serial No. 293,660

To all whom it may concern:

Be it known that I, Louis H. Ensten, citizen of the United States, residing at Cleveland, in the county of Cuyahoga and State of Ohio, have invented certain new and useful improvements in Knitted Caps, of which the following is a specification.

This invention pertains to knitted caps, and the object of the invention is to provide a knitted cap which will fit the head snugly and cover the ears and back of the neck and conform at its edge all around the cap to the exact contour of the neck, jaws and forehead of the wearer, and to hold its shape under elastic tension especially at the hollow places beneath the ear and behind the pivot bones of the jaw.

My idea also involves the making of a cap of the kind described by knitting a strip of goods in a flat form and with continuous selvages which have short sharp turns or angles varying in length at intervals to provide triangular portions of different size in the goods at each side or selvage, whereby one selvage may be folded to bring the edges together so that they may be sewed to form an ovate end for the cap, while the selvage on the other side of the goods will form an irregular scalloped edge adapted to conform to the neck and jaws and brow of the wearer in the manner and with the effect substantially as described.

In the drawings accompanying this application, Figure 1 is a perspective view of my improved knitted cap as it appears on the head. Fig. 2 is a view of a flat side of the piece of knitted goods having the shape and outline and the length required to produce my improved cap. Fig. 3 is a side view

of my improved cap as it apears when completed and folded flat. Fig. 4 is a rear view and Fig. 5 is a front view of the cap as it appears when folded flat, the heavy black lines denoting the sewed seams.

In knitting machine operations where a piece of goods is knitted in a flat form, it is a common practice to knit the rows in a zig-zag fashion so that the rows in successive areas of the strip are diagonally related with the selvage at each side running parallel to the rows and forming triangular areas in each side edge. This form of strip then is not broadly new, but in order to produce a cap such as I desire I form or produce triangular edge areas of different size successively in the strip and obtain this result by knitting broad and narrow rows successively. Thus, referring to Fig. 2 I show a flat knitted strip in which the two central rows 2 and 3, respectively, are relatively much smaller or narrower than the two rows 4 and 5 at the right hand side and the two rows 6 and 7 at the left hand side of the strip. The narrow rows form a central division in the strip in which the rows of knitting 2 are diagonally related to the rows of knitting 3, and the rows of knitting continue into the next and wider sections 4 and 6 without break or interruption, but diagonally in respect to the rows of knitting in sections 2 and 3. So also are the rows 5 and 7 diagonally related to the rows of knitting 4 and 6, respectively, and the end edges 8 and 9 of the strip are cut straight across the strip on the transverse line which represents the meeting line of other diagonal rows of knitting made in forming a long continuous strip of a multiple number of such pieces.

The opposite edges 10 and 11 of the knitted strip are selvages and cannot unravel, and the edge 10 borders two large triangular knitted areas 12 and 14, together with a much smaller triangular area 15 at an intermediate point. The edge 11 while also angular zigzags parallel to the opposite edge 10, but the triangular areas produced in opposite sides of the strip differ. Thus, two large and one small triangular areas are formed in edge 10, and two small triangular areas 16 and 17 are produced mid-length of the edge 11 together with semi-triangular areas 18 and 19 at the ends of the strip. This difference in formation at the opposite edges of the strip is of especial advantage and utility

in forming a cap of the shape desired and having characteristics which permit the knitted goods to stretch on the lines best adapted to make the cap conform to the head and to hold its shape and fit snug, especially at its bottom edge 10 in the triangular areas 5 and 6.

Thus referring to Figs. 3 to 5, inclusive, it should be noted that the selvage 11 is sewed together and makes a seam which will not unravel; that the selvage involved on the diagonally related lines between the apex or points of the two triangular areas 16 and 17, respectively, are relatively short and when sewed together are inconspicuous where appearing at the front side of the cap directly above the small triangular peak or area 15, see Fig. 5; that the selvage 11 [fol. 21] involved in the angularly-related lines between the outer ends of the strip and the points or tips of the triangular areas 16 and 17 may be sewed together to form a seam which will extend across the top of the cap and down at each side thereof for a short distance as indicated by the heavy black line 20 in Fig. 3, and in sewing this seam the line of union is on a substantially straight line as indicated by the numeral 21, Figs. 4 and 5, and which lines 21 correspond to the straight lines of selvage 11 between the areas 16, 17, 18 and 19.

The transverse end edges 8 and 9 of the knitted strip are also sewed together, thereby providing a vertical seam 23 which is located on a middle line at the rear side of the cap, see Fig. 4, and in order that the tips of the triangular areas 5 and 7 of the cap shall draw or tend to press inward when the cap is stretched over the head, I cut away or sever a triangular portion 24 from the strip at the point where the selvage 10 meets the end edges 8 and 9, respectively. The vertical seam 23 includes the oblique cut edges 25 so that in sewing the end edges together the rows of knitting 5 and 7 in the bottom portion of the cap are drawn and placed under tension to a considerable degree in the making of the cap and which tension is maintained and made manifest when the cap is placed on the head. Thus, the cap may be used frequently and a snug fit assured at the tips of the triangular areas 12 and 14, that is, the tension in the goods is sufficient to pull the tips inward beneath the ears and in the hollow behind the pivot bones of the jaw and not depend loosely and with unsightly effect. Also, the cap may be

turned up at its bottom edge and the triangular flaps will still fit tightly and snugly on the outer sides of the cap and conform to the head. That is, the goods will be flat and fit comfortably with only two thicknesses and not assume the shape of a bulky round roll, nor have an unsightly appearance.

What I claim is:

1. A knitted cap having triangular areas projecting downwardly at each side thereof and possessing an inherent tension adapted to provide a hugging fit at their tips when the cap is worn upon the head.

2. A knitted cap, comprising diagonally-related rows of knitting forming a depending triangular area at each side of the cap adapted to cover the ears when the cap is worn upon the head.

3. A knitted cap, comprising diagonally-related rows of knitting sub-divided into sections of different width forming a relatively small peak centrally at the front of the cap and relatively larger triangular areas and depending portions at each side of the cap.

4. A knitted cap, comprising diagonally-related rows of knitting at successive intervals, forming a pair of large triangular areas at one border edge of the cap, and providing a plural number of irregular angular areas at its opposite border edge, the edges of the irregular angular areas being sewed together and forming seams at the top of the cap.

5. A knitted cap, comprising a flat strip of knitted goods formed with selvages of angular formation, the transverse end edges of the strip and the adjacent angular edges of one of the selvages being sewed together to form the top of the cap, and the other selvage forming a centrally located front peak and a pair of relatively large triangular ear laps.

6. A knitted cap, comprising a flat strip of knitted material having selvages of angular form at each side; the end edges of the strip being cut on oblique lines transversely of the strip and sewed together; the adjacent angular portions of one selvage being sewed together to form a cap of ovate shape at one end; and the opposite selvage having a small

front peak for the cap and triangular ear laps at each side of the cap.

Signed at Cleveland, in the county of Cuyahoga, and State of Ohio, this 17th day of April, 1919.

Louis H. Ensten.

(Here follows advertisement, side folio 22)

[fol. 23] IN UNITED STATES DISTRICT COURT

AFFIDAVIT OF EDWIN A. HARRIS—Verified November 19, 1929

Edwin A. Harris, being first duly sworn, deposes and says:

I am of legal age. I reside at 314 W. 82nd St., in the City of New York and State of New York.

I am Treasurer of Simon Ascher & Co., Inc., defendant in the above entitled action.

I have read the bill of complaint, the affidavit of Louis H. Ensten attached thereto and the order to show cause.

I have been advised by counsel and on information and belief state that suit was brought on the patent here in suit in the Northern District of Ohio, Eastern Division by the patentee against Rich-Sampliner et al., and an interlocutory decree entered on May 24, 1922, holding claims 1, 3, 4 and 5 valid and infringed and claim 2 is invalid. The opinion of the District Court in this case (Equity No. 573) so far as I know was not reported in the Federal Reporter.

Appeal was taken by defendant from that portion of the decree of the District Court holding claims 1, 3, 4 and 5 valid and infringed, but no appeal was taken by plaintiff, one of the plaintiffs herein, from that portion of the decree holding claim 2 invalid. It is true as stated by Mr. Ensten in his affidavit attached to the bill of complaint herein that the Circuit Court of Appeals for the Sixth Circuit did not pass upon the validity of claim 2; but I am advised that it was because no appeal was taken as to claim 2, although plaintiff had a right to such appeal.

[fol. 24] On appeal on June 30, 1923, the Circuit Court of Appeals for the Sixth Circuit in Rich-Sampliner Co., et

PLAINTIFF'S EXHIBIT NO. 6 TO AFFIDAVIT OF L.H.ENSTEN

1879 • GOLDEN ANNIVERSARY FEATURES • 1929

THE "FISTO" CAP...

The sensation of Europe, produced in America by Ascher. It is one of the biggest hits in the GOLDEN ANNIVERSARY LINE! ..... Made—as is all Ascher merchandise—in our own mill in New York.

SIMON ASCHER & CO., INC.
SALESROOMS (NEW ADDRESS)
1 EAST 35th STREET, NEW YORK

WRITING SAY: I SAW IT IN EARNSHAW PUBLICATIONS

al. vs. Ensten, 291 Fed. 1003, sustained the District Court as to the validity and infringement of claims 1, 3, 4 and 5.

After the appeal on the interlocutory decree of the District Court to the Circuit Court of Appeals had been perfected, the plaintiff Ensten made application to the District Cort to be allowed to make the Lion Knitting Mills Company, its alleged licensee, party plaintiff. This application was denied.

Subsequently, another suit was filed against Rich-Sampliner Co., et al., by Ensten to the use of the Lion Knitting Mills Company, this suit being filed because the Master to whom the first suit had been referred for an accounting rejected proof of damages or loss of profits suffered by the Lion Knitting Mills Company, Ensten's alleged licensee, and because the District Court refused to permit the Lion Knitting Mills Company to be joined as a party plaintiff.

The opinion of the Court is reported in 13 Fed. (2d) 132.

In this suit the District Court found that a disclaimer of the subject matter of claim 2 which had been previously held invalid by the same District Court was not filed until April 30, 1924, two years after the entry of the decree of the District Court holding the claim invalid. According to the holding of Judge Westenhaver in this suit, plaintiff during these two years was insisting on his patent as entirety. He was having its date and number stamped on all products made in conformity to its disclosure, notifying [fol. 25] the general public of the extent of the patent and claiming by inference at least protection of all its claims. In two instances only did it appear that the attention of alleged infringers was called by him to the finding that claim 2 was invalid. This delay under the circumstances Judge Westenhaver held was unreasonable and held that the disclaimer statute not having been complied with the suit could not be maintained. The District Court, therefore, dismissed the suit.

Appeal was taken from this decree of the District Court to the Circuit Court of Appeals for the Sixth Circuit and the opinion is reported in 19 Fed. (2d) 66.

The Circuit Court of Appeals held that the new bill in which the licensee was joined as a party plaintiff was not an independent bill as it had been treated by the District

Court, because the Lion Knitting Mills Company was a proper party-plaintiff in the first suit, and to allow this joining in the second suit was only to correct a defect in the first. The Circuit Court of Appeals held that the proper status of the second bill was that of an amended bill, and that the fact of the failure to file a disclaimer within a reasonable time became a moot question. The Circuit Court of Appeals, therefore, did not pass upon the holding of the District Court that the failure to file a disclaimer within a reasonable time prevented the bringing of a subsequent suit upon the patent, but merely stated that it was unnecessary to decide this since it treated the second suit as an amended bill.

[fol. 26] In January of 1929, the caps complained of were first put on the market and advertised and became part of the regular line of goods of defendant.

At the time this complained of cap was first made and offered for sale by defendant, defendant had no knowledge of the patent in suit and the cap was a copy of a cap which had been brought into this country from Austria by the mother of Mr. George Brandenstein, who is in charge of the hand-made department of defendant.

Defendant received notice on June 1, 1929, signed by one Harold Elno Smith, that it was infringing the Ensten patent No. 1,313,080, the patent in suit, and inviting its attention to the fact that claims 1, 3, 4 and 5 of the patent, which contains six claims, had been held valid and infringed by the Circuit Court of Appeals of the Sixth Circuit, and that the opinion of this court was reported in 291 Fed. 1003, but this letter did not state that claim 2 of the patent had been held invalid by the District Court, that no appeal had been taken on claim 2 or that a disclaimer had not been filed until two years after the decree of the District Court holding this claim 2 invalid. A copy of this notice is attached to this affidavit as Defendant's Exhibit 1.

[fol. 27] DEFENDANT'S EXHIBIT NO. 1 TO AFFIDAVIT OF EDWIN A. HARRIS

Smith and Freeman, 1310 Hanna Building, Cleveland, Ohio

June 1, 1929.

Simon Ascher, 2443 Third Ave., New York City.

DEAR SIR: In behalf of our clients The Lion Knitting Mills Company and Louis H. Ensten, Cleveland, Ohio, we beg to draw your attention to the Ensten patent No. 1,313,080 and request that you would immediately desist from manufacturing and selling any caps which infringe the same, and further account to our clients for such profits as you and your customers have made therefrom in the past.

Your attention is invited to the fact that claims 1, 3, 4 and 5 of this patent were held valid and infringed by the Circuit Court of Appeals of the Sixth Circuit, C. C. A. 291 Fed. 1003, wherein a final decree has been entered only within the last few weeks.

We shall be pleased to be apprised of your intention in this regard.

Very respectfully, (Sgd.) Harold Elno Smith.

[fol. 28] IN UNITED STATES DISTRICT COURT

AFFIDAVIT OF ABRAHAM NITZBERG—Verified November 19, 1929

Abraham Nitzberg, being first duly sworn, deposes and says:

I am of legal age and reside at 2665 Grand Concourse, in the City of New York and State of New York.

I am a graduate of the City College of New York, having obtained a Bachelor of Arts degree in 1909.

I am factory manager for Simon Ascher & Company, Inc., and have been in the knit goods business for twenty-five years. I am thoroughly familiar with all the various methods of knitting apparel.

I have studied the Ensten patent No. 1,313,080 and am familiar with the construction of the cap and the method of knitting set forth in that patent.

The cap disclosed in the Ensten patent fits snugly over the head, has a peak extending downwardly over the forehead between the eyes and two substantially triangular portions which cover the ears. The whole cap is made up of diagonally related rows of knitting, the rows being of different widths. Two relatively narrow rows of knitting extend diagonally in opposite directions forming the front and peak of the cap, and two relatively wider rows of oppositely disposed diagonal knitting form each side of the cap and form the depending triangular portions which cover the ears. As this knitted piece is formed the edges are brought together and joined by stitching at the back, and the upper [fol. 29] edges of the rows of knitting which form the sides of the cap are brought together in a transverse line which will extend over the head and are stitched together. Thus, the cap is formed.

In the piece the corners are cut off as shown in the drawing at 24, so that when the back seam is formed the lower portion of the cap at the back is drawn in to fit the head.

I have examined the magazine "Sweater News" for September, 1918, and identify the two sheets marked Defendant's Exhibit 2, as photostats of the cover and page 14 of this issue of the magazine. On this page 14 a speedmask is illustrated. This speedmask includes a cap portion and a bib portion. The cap portion covers the head including the forehead and ears and the bib portion, the jaw, the neck and chest.

Basing my opinion upon my experience in the knit goods business, this picture shows that the front portion of the cap is made up of two areas which I have defined by red lines on the print marked Defendant's Exhibit 3 and attached hereto, and which areas I designate by the reference characters A and B. The knitting in area A extends in a diagonal direction opposite to the direction of the knitting in area B. Each side and one-half of the back is made up of two areas relatively wider than the areas A and B, which wider areas I designate by the reference characters C and D. The area C is made up of knitting in which the rows extend diagonally in a direction opposite to the direction

of the rows in area A. Area D is made up of diagonal rows [fol. 30] of knitting which extend in a direction opposite in respect of the direction of the rows in area C. Thus when the piece is knitted and before it is sewed up into a cap the lower edge has a point E which is in the form of a triangle and has two relatively larger points, one of which I mark F on the print, and the other of which is on the opposite side of the head. As these rows of knitting in each area are parallel the top of area A and the top of area B each are in the form of a point forming substantially a triangle, and the top edge of area C on each side is parallel with the corresponding edge at the bottom of the cap and the top edge of area D on each side is parallel with the corresponding edge at the bottom. Thus, the form of this piece before it is sewed together in the cap is the same as the form shown in Figure 5 of the Ensten patent in suit.

While the illustration in the "Sweater News" does not show the seam where the piece is formed into a cap, because it is knitted as I have described one seam must extend transversely across the cap and the other down the back just as is illustrated in Figures 3 and 5 of the Ensten patent.

It will be noted in the "Sweater News" advertisement that there is an area which I mark G in blue, which area is substantially triangular in form. This area is formed in this way: When the cap is sewed to the bib H the area D on each side is sewed to the upper edge of the bib with the rows of knitting parallel at M with the upper edge from the back of the head to the point F. In this condition the [fol. 31] rows of knitting in each of the areas C extend in a straight line from the point F to the point I where the area C joins the area A. To cover the cheek bones the edge of each area C is drawn forward by a pull applied to a central point at K until it reaches and is stitched to the bib at the point L. That this is the method of forming is shown by the fact that in the triangular area G the rows of knitting are stretched out.

Thus when the cap is formed it has a triangular area covering the forehead and triangular areas covering the ears. And because of the fact that the cap is of knitted form and particularly the areas C and D are of diagonal rows of knitting it possesses an inherent tension which will make it

hug the cheek, the ears and behind the ears, and the sides of the head of the wearer.

The attachment of the bib H does not deprive the cap portion of the mask of these functions, nor is it necessary to have the bib to assist the cap portion in performing these functions.

In the cap made and sold by Simon Ascher & Company, Inc., the seam is not down the back of the cap as in the Ensten patent but on the side over one of the ears, and the edges which are sewed together to form this seam are rectilinear. Thus, there is no cut-away portion corresponding to the portion 24 of the Ensten patent.

When this cap was first made by Simon Ascher & Company, Inc., it was made under my supervision and direction, and at that time I had not seen the Ensten patent and knew nothing of it whatsoever. The cap was made from a cap which had been presented to me by Mr. George Brandenstein [fol. 32] in charge of the hand-made department of Simon Ascher & Company, Inc., and who informed me that it had been brought over by his mother from Austria. I made a Chinese copy of this Austrian cap, and it is for that reason that the cap complained of in this suit is of its particular form.

(Here follows illustration from "Sweater News," side folio 33)

[fol. 34] IN UNITED STATES DISTRICT COURT

AFFIDAVIT OF L. H. ENSTEN—Verified November 25, 1929

Louis H. Ensten, being duly sworn, deposes and says, I am one of the plaintiffs in this case and have read the affidavit of Abraham Nitzburg, offered in behalf of the defense and verified the 19th day of November, 1929.

I notice that Mr. Nitzburg takes nearly all of the second page of his affidavit to refer to the cut-off portion 24 shown in Figure 2 of my patent in suit. It is customary for the plaintiffs to make such caps either with or without this cut-off portion. The matter is of minor importance from a manufacturing point of view and is in no way involved in the

DEFENDANT'S EXHIBIT NO.3 TO AFFIDAVIT OF ABRAHAM NITZBERG

Bradley
KNIT WEAR

SPEED MASK

THE Bradley *Speedmask* is knit close and thick of warm worsted yarn—it is long in front to protect the chest and long enough in back and at the sides to fit snugly and securely under coat or sweater. It is open just enough for clear vision and easy breathing—dipping low over the forehead, reaching down between the eyes and high on the cheeks for maximum protection.

The Bradley *Speedmask* is not only the ideal soldier's garment, but is the one best bet for winter sports,—aviating, riding, skiing, coasting, motoring, driving, skating and walking.

A special advertising campaign will tell the *Speedmask* story to millions

SAMPLES ON REQUEST

THE BRADLEY KNITTING CO.

DELAVAN, WIS.

patent in suit. Claim 6 which involves this feature has not been adjudicated.

I have examined the extracts of Sweater News of September, 1918. I am also familiar with the Speed Mask referred to in this advertisement, as it was one of the articles relied upon by the defendants in the Rich-Sampliner case, referred to in my earlier affidavit in this case. One of these Speed [fol. 35] Masks was in evidence and before the Court. The Court paid very little attention to it, although it considered it. In this Speed Mask there was a swatch but it was trimmed top and bottom and put together in a way different from my cap. The estimate sheet with the rough sketch and directions showing how to make this Speed Mask was before the Court as Defendant's Exhibit F. Exhibit E was also shown along with Exhibit F, and the two were reproduced on the same sheet of paper, and both of them related to head gear, one being intended for women and the other for men. Exhibit E showed what was called La Auto Hood.

The description which Mr. Nitzburg gives of the Speed Mask on pages 2, 3 and 4 in his affidavit is defective. He evidently did ont have a mask before him when he wrote up his description. What he had, evidently, was the rather crude advertising illustration to which he refers and which does not reveal the structure. I know, as a matter of fact, from a personal examination of the Speed Mask, that the principle swatch was trimmed top and bottom and the seam was at the side and came down over one ear. I cannot see that it has anything to do with my invention or in any way suggests the structure or subject matter of the claims of my patent. A full description of this Speed Mask is found at page 32 of the Circuit Court of Appeals record on Appeal #3776, referred to in my earlier affidavit. The description is given by Abram H. Lowe, a traveling salesman of the Bradley Knitting Co. of Delavan, Wis., who was called in [fol. 36] behalf of the defendants. His testimony as to this reads as follows:

"We later sold other head coverings using the zig-zag stitch, yes, sir; the Bradley Speed Mask so-called, marked Defendant's Exhibit D. I think this was first put into the line the spring of 1914, for delivery in the summer and fall of 1914. The company had these for sale up to and including the spring trip of 1920. We are still selling them, but

did not carry them on this fall's trip in 1920. The catalogue number is No. 1840.

"This neck piece of Exhibit D is made in two parts, front and back, and sewed together down the side and the lower knitted part of the cap, where the neck piece is attached, has been cut away from the original design. The lower portion has been cut away and is not shaped like the original cap as designed by Mr. Henry.

"This Exhibit D is seamed on both sides, but only part way down on the left. Exhibit C is apparently sewed all the way on the left side and part way on the right. Exhibit B is sewed all the way on the right side and partially on the left. In each of these cases apparently the back of the cap is integrally knitted.

"I couldn't say whether the top seam in Exhibit B is a selvage seam or a cut seam. I couldn't say whether the seam around the crown in Exhibit D is a selvage seam or a [fol. 37] cut seam. I couldn't say whether the seam at the crown in Exhibit C is a selvage seam or a cut seam.

"I think it is the custom of The Bradley Knitting Company to sew the caps by machinery. Upon inspection of Exhibits B and D I find the seams are machine made."

I further depose and say that I have consulted the opinion of Judge Westenhaver which appears in the printed record on Appeal No. 3776, to which I have already referred. From this, I quote:

"Nothing in the prior printed art describes this exact type of cap nor this mechanical process of producing one. Knitted caps, however, are old in the printed art, as well as in public use. The method of knitting the rows in a zigzag fashion so that the rows in successive areas are diagonally related to the selvage areas and to each other is, as stated in the patent, old and well-known practice. The novelty of plaintiff's invention resides in the different sizes of the several areas and the triangular edges thus produced and the manner of combining and bringing the same together. This specific form of construction is novel and in my opinion involved invention over the prior art.

"Of the prior patented art, defendants rely mainly on Ballentyne Canadian patent dated March 19, 1908; O'Shea United States Patent 1,255,559, dated February 5, 1918;

and Louis H. Ensten design patent 59,464, dated Septem-
[fol. 38] ber 23, 1919. Of the prior public uses, defendants mainly rely on the Canadian hockey cap previously made and sold by one of their predecessors in title and on what is known in the record as the Henry cap, and a ladies' auto hood and speed mask made and sold by the Bradley Knitting Company."

Following these quotations, the Court refers to certain alleged anticipations and particularly a cap known as the Henry cap which seems never to have gotten further than the experimental stage. I quote from the bottom of page 138 of the printed record:

"Henry's experimentation seems to have continued unaffected by this cap, and finally developed in the auto hood and the speed mask. These were described in printed catalogues, advertised, sold, and used beginning as early as 1913 and continuing through several succeeding years. They are not, however, any more nearly in point except as to the form of the knitting than is the O'Shea patent, and do not call for additional comment."

The Circuit Court of Appeals, when passing on the matter, the Court being composed of Judges Knappen, Denison and Donahue, passed on this prior use defense as follows:

"The Henry cap is undoubtedly the nearest approach to
[fol. 39] the cap in suit. It is not a part of the prior patent art and the district court properly held that the evidence of prior public use of the Henry cap was not sufficiently clear and definite to defeat the Ensten patent.

* * * * * *

"It is sufficient to say that the Henry cap not only fails to demonstrate its practical efficacy and utility in so far as the Ensten idea is concerned, but on the contrary, it is so constructed as to conceal any inherent qualities it may possibly possess in common with the Ensten cap. It follows that the doctrine announced in Buser v. Novelty Tufting Co., 151 Fed. 478, has no application to this case."

[fol. 40] IN UNITED STATES DISTRICT COURT

OPINION, CAFFEY, D. J.

I agree with Judge Westenhaver (Ensten v. Rich-Sampliner Co., 13 Fed. [2d] 132; reversed on another point, 19 Fed. [2d] 66) that, within the meaning of the disclaimer statute (35 U. S. C. A., sec. 71), the plaintiff has "unreasonably neglected or delayed to enter a disclaimer" of claim 2. At the least, the question is so doubtful that no injunction pendente lite should issue.

There is nothing in R. Hoe & Co. v. Goss Printing Press Co., 31 Fed. (2d) 565, to help plaintiff, because the facts are lacking here to which what was there held is applicable.

The sole contention to the contrary is based on the following: The plaintiff was free to refrain from exercising his right to appeal from the interlocutory decree by the Ohio District Court in 1922. He was entitled to avail himself of an appeal from the final decree in that cause as a means of reviewing the adjudication by the interlocutory decree of the invalidity of claim 2. He argues that, in consequence, his time for filing a disclaimer was extended until a reasonable time after such final decree or even further thereafter according to the schedule prescribed by the Hoe case for taking the other steps open to him.

The conclusion urged by plaintiff, however, does not follow. To sanction it would weaken, if not destroy, the mandatory requirement and would frustrate the purpose of the statute.

As I see the situation, when the interlocutory decree was rendered plaintiff was put into the position where he was compelled to choose between two courses: (1) he could ap- [fol. 41] peal from the interlocutory decree and thereby extend, until expiration of a reasonable time after decision by the highest court available of the question of invalidity involved in the interlocutory decree, the time within which to file a disclaimer in the patent office without endangering the balance of the claims or (2) he could forego his right to appeal from the interlocutory decree and stake his whole case for an extension of the date by which to renounce on procuring reversal of that decree when he later appealed from the final decree.

It is clear that if plaintiff had pursued the entire gamut of permissible appellate procedure, and thereby had procured a reversal of the adverse provision on claim 2 embodied in the interlocutory decree, he would have escaped the penalty attached to judicial determination in the interlocutory decree of the invalidity of the claim. But the plaintiff did not take that course. He did not appeal. He did not obtain a reversal. He abandoned the chance to get one by filing a disclaimer in 1924. He made no effort to benefit by the rights accorded him by the rule laid down in the Hoe case. The interlocutory decree still stands. With it thus in full force as to claim 2, his duty under the disclaimer statute must be measured by the fact that it remains in force.

What the argument of plaintiff comes to is to say that the mere existence of the right to postpone appealing from an interlocutory decree, coupled with the right to review it on appeal from the final decree, of necessity prolongs the [fol. 42] period for filing a disclaimer, so that time begins to run under the disclaimer statute only after final decree. Otherwise stated, the argument is that the period intervening between interlocutory and final decrees cuts no figure in estimating how long, after the first judicial condemnation of a claim, a patentee has to disclaim in order to preserve the remaining portions of the patent. To interpret the statute governing appeals to have the effect of modifying the disclaimer statute to this extent would go far beyond anything said in the Hoe case or in any other case called to my attention. It would create a loophole in the disclaimer statute which would permit speculation by a patentee after he had been judicially told that his monopoly would expire unless, within a reasonable time, he relinquished his invalid claim.

The delay in filing the disclaimer until nearly two years after the interlocutory decree, with the incidental insistance in the meanwhile on the validity of the claim, is fatal to the present suit. Motion denied.

Dated, December 9, 1929.

Francis G. Caffey, U. S. D. J.

[fol. 43] IN UNITED STATES DISTRICT COURT

FINAL DECREE

This cause came on to be heard at this term on plaintiffs' motion for a preliminary injunction, affidavits were filed on behalf of both parties and argument was had by counsel representing both parties; and thereupon, upon consideration thereof, it is

Ordered, Adjudged and Decreed as follows, viz:

1. That plaintiffs' motion for preliminary injunction be and hereby is dismissed on the ground that there is at least sufficient doubt that the plaintiff Ensten did not unreasonably neglect or delay to enter a disclaimer of claim 2 to defeat the issuance of an injunction pendente lite.

2. That the bill of complaint be and hereby is dismissed with costs to defendant on the ground that the plaintiff Ensten did unreasonably neglect or delay to enter a disclaimer as to claim 2.

Enter.

Francis G. Caffey, U. S. D. J.

Approved as to form: O. Ellery Edwards, Solicitor for Plaintiffs. Hoguet & Neary, Solicitors for Defendant.

December 10th, 1929.

[fol. 44] IN UNITED STATES DISTRICT COURT

PETITION FOR APPEAL AND ASSIGNMENT OF ERRORS

To the Honorable the District Judges of the United States in and for the Southern District of New York:

The above named plaintiffs, Louis H. Ensten and Lion Knitting Mills Company, conceiving themselves to be aggrieved by the final decree made and entered herein in this case on December 10th, 1929, wherein a motion for a preliminary injunction was denied, and the bill of complaint dismissed with costs, do hereby appeal to the United States

Circuit Court of Appeals, in and for the Second Circuit from such decree, for the reasons set forth in the assignment of errors forming a part hereof, and they pray that this, their petition for an appeal may be allowed and that a transcript of the record and proceedings upon which said decree was entered may be transmitted with this appeal to the said Circuit Court of Appeals.

The said plaintiffs transmit with the above petition for appeal, the following assignment of errors:

1. That the District Court erred in refusing to grant plaintiffs' motion for a preliminary injunction.

2. That the District Court erred in dismissing the bill of complaint with costs.

Louis H. Ensten and Lion Knitting Mills Company,
by O. Ellery Edwards, Their Solicitor.

[fol. 45] IN UNITED STATES DISTRICT COURT

ORDER ALLOWING APPEAL

It is ordered this 10th day of December, 1929, that the foregoing appeal be allowed, and shall become effective upon the filing of a bond or undertaking, duly aproved by this court, in the sum of $250.00.

Jno. C. Knox, U. S. D. J.

Bond approved and filed December 10th, 1929.

Citation, in usual form, showing service on Hoguet & Neary, omitted in printing.

[fol. 46] IN UNITED STATES DISTRICT COURT

STIPULATION AS TO CONTENTS OF RECORD

It is hereby stipulated by and between the respective parties hereto that the Record on Appeal herein shall be composed of the following papers, viz:

[fol. 47] 1. Verified Bill of Complaint.

2. Order to Show Cause dated November 9, 1929.

3. Affidavit of L. H. Ensten verified November 8, 1929.

Plaintiffs' Exhibit 1—Final Decree in action in Ohio Court in re: Ensten v. Rich-Sampliner Company.

Plaintiffs' Exhibit 2—Patent No. 1,313,080 issued to L. H. Ensten.

Plaintiffs' Exhibit 6—Sheet from the Earnshaw Publication.

4. Affidavit of Edwin A. Harris, verified Nov. 19, 1929.

Defendant's Exhibit 1—Letter from H. E. Smith to defendant dated June 1, 1929.

5. Affidavit of A. Nitzberg verified November 19, 1929.

Defendant's Exhibit 3—Diagram on photostat of page 14, Sweater News, Sept., 1918.

6. Affidavit of L. H. Ensten verified Nov. 25, 1929.

7. Opinion of Judge Caffey dated December 9, 1929.

8. Final Decree dated December 10, 1929.

[fol. 48] 9. Petition, Assignment of Errors, and Citation.

10. This stipulation.

11. Clerk's Certificate.

O. Ellery Edwards, Solicitor for Plaintiffs-Appellants. Hoguet & Neary, Solicitors for Defendant-Appellee.

Dated N. Y., December 12th, 1929.

So ordered. Jno. C. Knox, U. S. D. J.

[fol. 49] In United States District Court

[Title omitted]

Stipulation re Record

It is hereby stipulated and agreed, that the foregoing is a true transcript of the record of the said District Court in the above-entitled matter as agreed on by the parties.

Dated January —, 1930.

O. Ellery Edwards, Solicitor for Appellants. Hoguet & Neary, Solicitors for Appellee.

[fol. 50] Clerk's certificate to foregoing transcript omitted in printing.

[fol. 51] In United States Circuit Court of Appeals for the Second Circuit

Louis H. Ensten and Lion Knitting Mills Company, Appellants,

vs.

Simon Ascher & Co., Inc., Appellee

Before Swan, Augustus N. Hand, and Chase, Circuit Judges

Appeal from the District Court of the United States for the Southern District of New York

Bill of complaint charging infringement of letters patent No. 1,313,080, to Ensten, filed by the patentee and his exclusive licensee, against Simon Ascher & Co. Upon plaintiff's motion for a preliminary injunction, the injunction was denied and the bill was dismissed. The plaintiffs have appealed. Affirmed.

The district court entered its decree on the ground that the patentee had unreasonably delayed the filing of a disclaimer as to claim 2 of the patent in suit, which claim had been held invalid by an interlocutory decree in a prior infringement suit against a different defendant. That suit was brought by Ensten in the district court for the Northern District of Ohio. In May, 1922, an interlocutory decree was [fol. 52] entered therein holding certain claims of the patent valid and infringed, and claim 2 invalid. On appeal by defendants that decree was affirmed. Rich-Sampliner Co. v. Ensten, 291 F. 1003 (C. C. A. 6). However, the invalidity of claim 2 was not there passed upon, as Ensten had not appealed. The mandate was filed October 18, 1923, and thereafter on April 30, 1924, Ensten disclaimed as to claim 2. Not until November 1, 1928, after damages were agreed upon, was the final decree entered therein. Because of the foregoing facts, which disclose that no disclaimer was filed until approximately two years after entry of the interlocutory decree declaring claim 2 invalid, the court below held that

the whole patent was rendered void by reason of sections 4917 and 4922 of the Revised Statutes (35 U S C A secs. 65, 71).

O. Ellery Edwards for Appellants.

Hoguet & Neary (Daniel L. Morris, of Counsel) for appellee.

OPINION

Per CURIAM:

The question is whether a patentee, to save the life of his patent, when one claim thereof has been held invalid by an interlocutory decree, must either appeal from such decree, or promptly file a disclaimer. With respect to this very patent, Judge Westenhaver held that he must. Ensten v. Rich-Sampliner Co., 13 F. (2d) 132; but this was reversed on another point, and the disclaimer question called moot, in 19 F. (2d) 66 (C. C. A. 6). In the case at bar, the court below followed the reasoning of Judge Westenhaver.

The appellants contend that election between the alter- [fol. 53] natives of appeal or disclaimer should not be required until entry of a final decree. They argue that an interlocutory decree does not finally determine the invalidity of a claim because the correctness of such interlocutory ruling may be questioned upon an appeal from the final decree; that to require a patentee to elect between appealing and disclaiming when only an interlocutory decree has been entered, allows him the privilege of testing the interlocutory ruling upon appeal from the final decree only at the risk of losing his entire patent, if he fails to reverse the interlocutory order; and that the disclaimer statute should not be construed to have contemplated any such result. However persuasive these arguments might appear to the court as now constituted, we think we are foreclosed from considering them by the recent decision of Hoe v. Goss, 31 F. (2d) 565. There the plaintiff's bill was dismissed for non-infringement. On appeal this court reversed the decree, holding one claim of the patent good and several invalid. 30 F. (2d) 271. Our decree was interlocutory, and yet, on motion to recall and amend our mandate, we required the plaintiff either to petition for certiorari or to file a disclaimer within 30 days after expiration of the time for such a petition. The logic of that decision is equally applicable to an interlocutory decree of the district court. In fact, in such case it

operates with slightly less severity, for the patentee may appeal as of right from the district court, while the entertainment of his petition for certiorari is a matter of grace. Ad-
[fols. 54 & 55] herence to the Hoe case requires an affirmance of the decree below.

This decision appears to be in direct conflict with the principle upon which a decision of the Seventh Circuit has very recently been handed down. Excelsior Steel Furnace Co. v. F. Meyer & Brother Co., published in U. S. Daily for January 18, 1930. In that litigation the patentee's bill was dismissed by the district court. On appeal certain claims were held valid and others invalid, the opinion being rendered in May, 1917 (244 F. 172). Thereafter, the district court entered an interlocutory decree for injunction and accounting. During the accounting, in February 1922, the defendant asked for dismissal of the suit because no disclaimer had been filed. The motion was sustained by the district court. This action the Circuit Court of Appeals has reversed, holding that the delay was not unreasonable since the prior decision was merely interlocutory and the plaintiff could reasonably delay the filing of its disclaimer until after the final decree. In view of this diversity of views between two circuit courts of appeals, it would seem probable that the appellants can secure a certiorari, if so disposed, and thus enable this important question of the law of patents to be authoritatively determined. Decree affirmed.

[fol. 56] In United States Circuit Court of Appeals, Second Circuit

Louis H. Ensten and Lion Knitting Mills Company, Plaintiffs-Appellants,

v.

Simon Ascher & Co., Inc., Defendant-Appellee

Appeal from the District Court of the United States for the Southern District of New York

Decree—Filed Feb. 4, 1930

This cause came on to be heard on the transcript of record from the District Court of the United States for the Southern District of New York and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged, and decreed that the decree of said District Court be, and it hereby is, affirmed, with costs.

It is further ordered that a Mandate issue to the said District Court in accordance with this decree.

Wm. Parkin, Clerk.

[File endorsement omitted.]

[fol. 57] Clerk's certificate to foregoing transcript omttted in printing.

[fol. 58] SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed March 12, 1930

The petition herein for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit is granted. And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

Endorsed on cover: File No. 34,781. U. S. Circuit Court of Appeals, Second Circuit. Term No. 650. Louis H. Ensten and Lion Knitting Mills Company, petitioners, vs. Simon Ascher & Company, Incorporated. Petition for writ of certiorari and exhibit thereto. Filed February 10, 1930. File No. 34,781.